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Supreme Court of the United States

October Term, 1947

No. 652

HAROLD E. EDGERTON,

Petitioner,

vs.

**LAWRENCE C. KINGSLAND, Commissioner
of Patents,**

Respondent.

**PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR
THE DISTRICT OF COLUMBIA**

REPLY BRIEF FOR THE PETITIONER.

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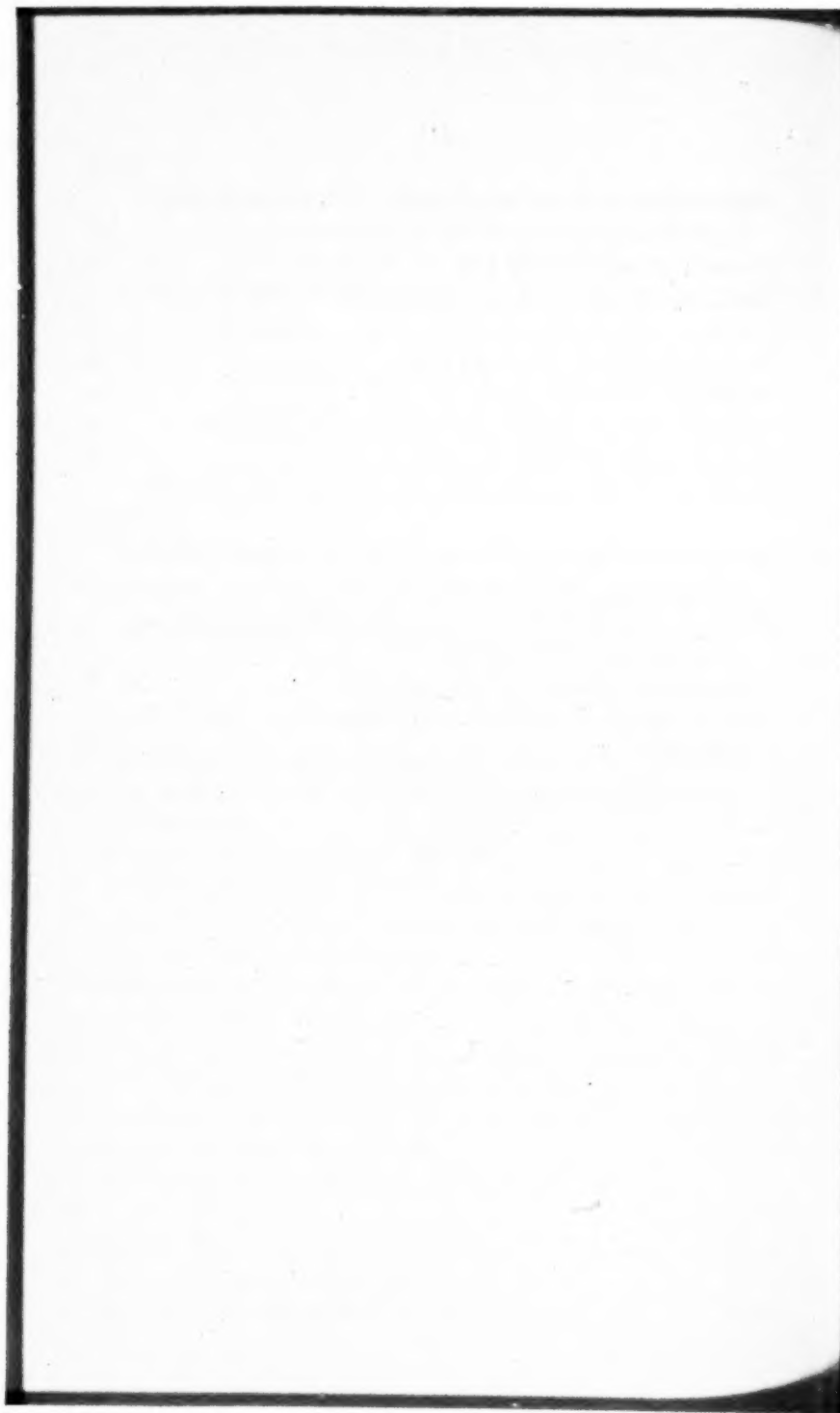
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REPLY BRIEF FOR THE PETITIONER

INTRODUCTION

The brief accompanying the petition had explained that, in refusing to entertain piecemeal appeals from lower courts, this Court and the Courts of Appeals were but complying with the requirements of legislation enacted by "Congress from the very beginning" (Pet. 17); and that "This carries out a federal policy going back to the early days of the Republic" (Pet. 18), a policy, moreover, that "was only declaratory of a well settled and ancient rule of English practice" (Pet. 17). The brief had further made clear that, partly as (Pet. 24)

“an aspect of the procedural philosophy pertaining to the federal courts whereby, ever since the Judiciary Act, Congress has been loath to authorize review of interim steps in a proceeding,”

the same policy has been in force in connection with piecemeal appeals from administrative bodies. Since the Patent Office is an administrative body (Pet. 24), this policy must naturally apply also to appeals from the Patent Office. The brief further demonstrated that Section 4915 of the Revised Statutes had accordingly never heretofore been permitted to be invoked until after a *final* decision by the Patent Office upon the *whole merits* of the patent application.

The only rulings to the contrary, it seems, that have ever been made by either the Patent Office or any court were the rulings in the case at bar, and the Court of Appeals for the District of Columbia frankly cited as its only authority the holdings of this Court in *Hoover Co. v. Coe*, 325 U. S. 79 (Pet. at the very bottom of page 3).

I. “The sole question presented by the petition.”

The petition (Pet. 2) had therefore presented the following question, of great public importance (Pet. 4, 5):

“The question presented, therefore, is whether, from now on, contrary to the practice heretofore prevailing, it will be necessary for a patent applicant to resort to the District Court piecemeal upon each and every separate occasion that the Patent Office may render a separate decision involving one or more separate claims of the patent application.”

On page 5, the respondent appears to agree that this is “The sole question presented by the petition.”

The respondent (page 5) accepts

“the general rule that the piecemeal disposition on appeal of a single controversy is not permissible (Pet. 15-24)”,

and he agrees that the present petition deals with such a "single controversy" (Pet. 18 to 22). He appears, furthermore, not to question the petitioner's demonstration that, in construing Section 4915 of the Revised Statutes,

1. This very court, in *Butterworth v. Hoe*, 112 U. S. 50, had (Pet. 29)

"indicated that the record in a suit under Section 4915, R. S. should include the *whole merits* of the applicant's right to a patent" (*italics supplied*);

2. The Court of Appeals of the District of Columbia, as in *Cosper v. Gold*, 34 App. D. C. 194, 197, had (Pet. 25)

"had occasion heretofore to call attention to the fact that the jurisdiction of this court to entertain appeals from the Commissioner of Patents is limited to two classes of decisions, namely,"

ex parte cases, like the case at bar, and *inter partes* cases, involving interferences, and that, in *ex parte* cases,

"the jurisdiction of this court * * * is limited to * * * a *final* rejection of an *application* for patent (*italics supplied*),

and not merely, as the respondent argues, below the middle of page 5, on page 6, line 4, on page 10, line 3, and elsewhere, a rejection of "any claim," "any individual claim" or "any one" of the claims of the application for patent;

3. The Court of Customs and Patent Appeals is in full agreement with the Court of Appeals of the District of Columbia, both with regard to *ex parte* cases (Pet. 28), in *re Rundell*, 55 F. 2d 450, 454 (though the respondent, page 8, appears to dispute the petitioner's understanding of this decision), and, as demonstrated by the decisions cited at the bottom of page 27 of the petition, in *inter partes* cases also; and

4. The Commissioner of Patents, at one time, at least, was also in agreement, *ex parte* King, 336 O. G. 3 (Pet. 26, 27).

The respondent appears, however, to argue somewhat as follows:

1. Though he appears not to dispute that the decision of this Court, in *Butterworth v. Hoe supra*, is in accordance with (page 5)

“the general rule that the piecemeal disposition on appeal of a single controversy is not permissible (Pet. 15-24)”,

he apparently considers that this Court has established an exception to this “general rule” in *Hoover Co. v. Coe, supra*, “the full significance” of which, the respondent says (bottom of page 7), the petitioner has “failed to grasp”.

2. From page 6 of his brief, it would appear that the respondent is prepared to agree that, prior to the decision of this Court in the *Hoover Co. case, supra*, and even up to the time of its own decision in that case (144 F. 2d 514), the Court of Appeals of the District of Columbia was still following the practice of *Cosper v. Gold, supra*, relating to

“piecemeal relief pending completion of the administrative process and therefore ought not to entertain a suit under the R. S. 4915 unless its adjudication would conclude all possible questions as to the right to a patent,”

not merely (p. 3, *supra*) the right to “any claim”, “any individual claim” or “any one” of the claims of the application for the patent.

3. The respondent argues (page 8), however, that since, in accordance with three of its decisions, the Court of Customs and Patent Appeals heretofore

"has entertained appeals in cases in which all claims had not been finally disposed of in the Patent Office," under the provisions of Section 4911 of the Revised Statutes,

"it follows that the rejection of *any claim* in a patent application gives the applicant a right to a judicial determination on a bill in equity" (italics supplied) in the District Court, under the provisions of Section 4915 of the Revised Statutes.

4. As for the decision of the Commissioner of Patents, in *ex parte King*, 336 O. G. 3, *supra*, the respondent argues (page 8) that it

"purports to be no more than a construction of the Patent Office's Rule 139;"

that, in any event, it was a decision rendered in 1927; and that

"that construction had obviously been changed in 1941."

5. The respondent argues also (pages 9 and 10) that the words,

"his claim *or for any part thereof*" (italics the respondent's)

in Section 4915 of the Revised Statutes

"indicates that the controversy presented may be the validity of only a part of the subject matter of the entire application,"

a conclusion for which he finds reinforcement (page 8) in Section 4909 of the Revised Statutes.

II. The "academic" question raised by the respondent.

Though, it is believed, this fairly summarizes the contentions of the petitioner and the respondent relating to what the respondent himself terms "The sole question presented by the petition", the respondent nevertheless raises also a

further question, additional to this "sole question", namely (page 5),

" * * * that, in any event, the petitioner has failed to show that the rejection of his static inverter claims by the primary examiner, the Board of Appeals, and the District Court was clearly erroneous."

In view of this additional question, the respondent says that (page 10)

"the question of the correct interpretation of R. S. 4915 is academic, as petitioner has made no showing that he is entitled to relief on the merits."

In order to demonstrate that "the correct interpretation of R. S. 4915" is *not* "academic", it now becomes necessary to discuss several matters that, in the interest of brevity, were not even mentioned in the petition.

III. Facts upon which the petitioner and the respondent appear to be agreed.

The petitioner and the respondent appear to agree upon quite a number of matters of fact. Among these (Pet. 6 to 8) are that, during the pendency of the petitioner's application, the Patent Office, without interference previously declared, had inadvertently issued to a predecessor of the Cities Service Oil Co. a patent containing the static-inverter claims 74 and 76 to 81 involved on this petition; that, at the petitioner's instance, Interference 74,402 was thereupon belatedly declared between this patent and the petitioner's application; and that this interference was later dissolved upon the ground that the petitioner's application (Respondent's brief, page 3)

"has not disclosed a 'static inverter' as required by claims 74 and 76-71 * * * (R. 259)."

The respondent further appears not to dispute the petitioner's statement that the Patent Office did not at that time

actually know what is a static inverter, and that it nevertheless refused to accept any evidence demonstrating that the holding that the petitioner's application does not disclose a static inverter was contrary to scientific fact (Pet. 8). As in *Sinko Tool & Manufacturing Co. v. Automatic Devices Corporation*, 157 F. 2d 974, 978, the Patent Office considered itself to be "endued", in Judge Learned Hand's words,

"with that specialized acquaintance with the subject matter which enables it to dispense with evidence and draw upon undisclosed sources of information, not available to us and unknown to the parties."

It appears to be also agreed that, since the decision dissolving the interference was not a final decision upon the whole merits, the petitioner was at that time without remedy to obtain a court review of the holding that the petitioner's application does not disclose a static inverter; and this either in the District Court, under the provisions of Section 4915 of the Revised Statutes, or in the Court of Customs and Patent Appeals, under the provisions of Section 4911 of the Revised Statutes. It appears to be further agreed that, as a preliminary to such court review, it became necessary for the petitioner (again at his own instance, R. 257) to resume the *ex parte* prosecution of the application, in order to obtain an adjudication of the remaining claims of the application (Pet. 8 and 9); but that this *ex parte* prosecution resulted, in 1941, in only a piecemeal decision by the Patent Office relating to the static-inverter claims 74 and 76 to 81 only, still without any final decision upon the whole merits (Pet. 9).

At this point, the respondent's brief (page 5) contends that, notwithstanding the fact that there had not, as yet, been any final decision in the Patent Office upon the whole merits, the Court of Appeals of the District of Columbia has never-

theless "properly applied the decision of this Court in *Hoover Co. v. Coe*", *supra*, in that it "correctly interpreted R. S. 4915" as requiring that the petitioner should have filed his complaint within six months of that 1941 piece-meal decision (page 8 of the respondent's brief)

"without the necessity of waiting until there had been a final disposition of all claims."

There are several further matters of fact upon which the petitioner and the respondent appear to be agreed. At the time of the later final action upon the whole merits of the petitioner's application, in 1945, the Patent Office withdrew entirely from its original holding that the petitioner's application does not disclose a static inverter. That original holding, upon the basis of which the interference had been dissolved, was therefore completely abandoned and, as appears from page 4 of the respondent's brief, a new ground of rejection was offered, instead, namely,

"that the previous final rejection of them [the static-inverter claims 74 and 76 to 81] was *res judicata* as the time for further appeal had expired (R. 286, 500)."

It is desired to emphasize that that new ground became now the *sole* ground of rejection (R. 513, 518, 523). The Patent Office made no further attempt to justify its original erroneous holding, contrary to scientific fact, that the petitioner's application does not disclose a static inverter. It may be of significance to add that the Patent Office had meantime had access to the *inter partes* testimony in *Cities Service Oil Co. v. Edgerton*, 56 F. Supp. 294 (R. 513, 523).

It appears to be also agreed, however, that the District Court, unlike the Patent Office, was not content to base its rulings upon the ground of *res judicata* alone. On the contrary, the District Court considered it to be wise to attempt to strengthen its holding as to *res judicata* by resurrecting

the rejection, already dead in the Patent Office itself, upon the ground that the petitioner's application does not disclose a static inverter. As the opening sentence of the respondent's brief admits, the District Court did not, however, write any opinion explaining why the petitioner's application does not disclose a static inverter. The District Court did not, as a matter of fact, even mention the term "static inverter". In the language at the bottom of page 10 of the respondent's brief, the District Court considered it to be sufficient to rule only that

"the disclosure in the application did not support any of the claims here involved."

It is likewise agreed that the Court of Appeals was apparently not so satisfied as was the District Court about the advisability of reviving this previously dead issue (page 5 of the respondent's brief):

"On appeal the Court of Appeals for the District of Columbia considered it necessary to discuss only the *res judicata* question, and affirmed the District Court on that ground on the authority of this Court's decision in *Hoover Co. v. Coe*, 325 U. S. 79, which was deemed to be controlling (R. 582-583, 586)."

It is therefore further agreed that the petitioner has never had a ruling from the Court of Appeals as to whether the Patent Office was wrong in burying, and the District Court was therefore right in resurrecting, the rejection upon the ground that the petitioner's application does not disclose a static inverter.

It is in order, therefore, to discuss two questions in this reply brief: one, the question that the respondent admits is "The sole question presented by the petition"; and secondly, the "academic" question raised by the respondent. These will be treated in inverse order.

SUMMARY OF ARGUMENT

I. The question newly raised by the respondent is not "academic".

II. As for "the sole question raised by the petition",

1. The practice with regard to piecemeal appeals heretofore in force in

A. This Court,

B. The Court of Appeals of the District of Columbia,

C. The Court of Customs and Patent Appeals, and

D. The Patent Office

has not been revolutionized; for

E. *Hoover Co. v. Coe*, 325 U. S. 79, has not changed this practice.

2. The words "his claim or for any part thereof" in Section 4915 of the Revised Statutes relate to the relief that the District Court may give, and not to its jurisdiction.

3. The different language employed in Sections 4909 and 4915 of the Revised Statutes serves but to emphasize that a suit under Section 4915 of the Revised Statutes may not be filed until after a final decision upon the whole merits.

ARGUMENT

I. The question newly raised by the respondent is not "academic".

After admitting (page 5), as before stated, that the Court of Appeals declined to approve the District Court's ruling that the disclosure of the petitioner's application does not support the static-inverter claims 74 and 76 to 81

involved on this appeal, the respondent presents the argument that (pages 10, 11)

"the question of the correct interpretation of R. S. 4915 is academic",

because

"Although this ground of decision was not considered by the court below on the appeal, in the review of proceedings under R. S. 4915 that court has consistently applied the well-established rule that findings of fact of the trial court will not be disturbed unless clearly erroneous or without support in the evidence. * * * This rule has peculiar force where, as here, the contested finding has been concurred in by both the Patent Office and the District Court."

There are at least five fallacies in this argument.

First, in the present instance, it appears to be agreed (p. 9, *supra*) that the Court of Appeals has thus far refused either to disturb or not to disturb any "findings of fact of the trial court." The one matter relating to *res judicata* decided by the Court of Appeals relates to a conclusion of law, and not any "findings of fact."

Secondly, it appears also to be agreed, as already stated, (p. 9, *supra*), that there have never been any "findings of fact of the trial court" to the effect that the petitioner's application does not disclose a static inverter. The exact rulings of the District Court were (R. 29):

"4. The plaintiff's application here involved does not contain a disclosure which will support any of claims 74, 76 to 81, inclusive, and 222 of his application here involved.

5. The plaintiff is not entitled to make any of the claims 74, 76 to 81, inclusive, and 222 of his application here involved."

These fourth and fifth findings of alleged fact clearly do not constitute a holding to the effect that the petitioner's application does not disclose a static inverter. They say no more than does the second conclusion of law (R. 29):

"2. The plaintiff is not entitled to any claims set forth in the complaint."

They do not present any "findings of fact of the trial court" whatever, not even a finding of "underlying fact", as required in *Schneiderman v. United States*, 320 U. S. 118, 129:

"The pertinent findings of fact on these points, set forth in the margin, are but the most general conclusions of ultimate fact. It is impossible to tell from them upon what underlying facts the court relied, and whether proper statutory standards were observed."

This may explain why the Court of Appeals preferred to base its ruling upon the ground of *res judicata* alone.

Thirdly, there cannot have been any "concurrence" in any "findings of fact of the trial court" to the effect that the petitioner's application does not disclose a static inverter because the trial Court, as already explained, p. 9, *supra*, never made either that or any other "findings of fact" relating to the static inverter. But even if there had been any "findings of fact of the trial court", instead of a mere conclusion of law, and even if those "findings of fact of the trial court" had constituted findings to the effect that the petitioner's application does not disclose a static inverter, there still could not have been any "concurrence," because the Patent Office had by that time itself abandoned that erroneous ground of rejection.

As for the fourth fallacy in the respondent's newly presented argument relating to "The sole question presented by the petition" being "academic", the Court of Appeals has thus far refused to hold that the fourth and fifth findings of alleged fact of the District Court were or were not "clearly erroneous."

And fifthly, the Court of Appeals has similarly thus far refused to hold that these fourth and fifth findings of alleged facts were or were not "without support in the evi-

dence". In a footnote on page 3, on the contrary, the respondent himself refers to some of the uncontradicted testimony of witnesses of unimpeachable character in the District Court (testimony which the petitioner was not permitted to present before the Patent Office, Pet. 8) proving conclusively that the petitioner's application does disclose a static inverter. There is not the slightest evidence to the contrary; not even the "mere scintilla" referred to by this Court in *Consolidated Edison Co. v. National Labor Relations Board*, 305 U. S. 197, 229, and *National Labor Relations Board v. Columbian Enameling & Stamping Co.*, 306 U. S. 292, 300, let alone the "substantial evidence" required by these decisions.

II. "The sole question raised by the petition".

1. *The Practice With Regard To Piecemeal Appeals Heretofore In Force Has Not Been Revolutionized.*

A. The Law As To Piecemeal Appeals In This Court.

The views of the petitioner and the respondent have been stated on pages 3 and 4, *supra*.

B. The Law As To Piecemeal Appeals In The Court of Appeals of the District of Columbia.

The views of the petitioner and the respondent have been stated on pages 3 and 4, *supra*. In view of some of the respondent's arguments, however, it is desired to invite attention to the fact stated in *re Hien*, 166 U. S. 432, 439, that

"The bill in equity provided for by Section 4915 is wholly different from the proceeding by appeal from the decision of the Commissioner under consideration

in this case. The one is the exercise of original, the other, of appellate, jurisdiction."

C. The Law As to Piecemeal Appeals in the Court of Customs and Patent Appeals.

In support of his thesis that the Court of Customs and Patent Appeals will entertain jurisdiction of piecemeal appeals under the provisions of Section 4911 of the Revised Statutes, the respondent, as before stated, cites three decisions.

In re Gillam, 37 F. 2d 959, 960, the Court of Customs and Patent Appeals held that, once it had obtained jurisdiction by the perfecting of an appeal from a final decision of the Patent Office upon the whole merits, that jurisdiction could not thereafter be ousted merely by its being

"*brought to our attention by counsel for the appellant that, since the present appeal was perfected, the Patent Office has permitted the filing of amended claims herein, and has caused certain interference issues to be made up between this application, as amended, and a certain other application*" (italics supplied).

The Court of Customs and Patent Appeals adhered to this ruling *in re Robertshaw*, 75 F. 2d 203, following the precedent established in *Roemer v. Simon*, 91 U. S. 149, reaffirmed in *Realty Acceptance Corp. v. Montgomery*, 284 U. S. 547, 551.

As for *in re Rundell*, 55 F. 2d 450, the petitioner has already explained (Pet. 28) that even the dissenting opinion was opposed to the view contended for by the respondent.

In that case, the Patent Office had held that an applicant for a patent, in a single application, had presented two sets of claims directed to two separate and distinct inventions.

The claims of one set covered a complete machine for crimping plastic caps on bottles. The claims of the other set covered a part only of the machine, a sub-combination involving a crimping die or head.

The Patent Office required "division", or an election as to which of the two inventions was to be prosecuted in the one application; and the Court of Customs and Patent Appeals held that Section 4911 of the Revised Statutes conferred jurisdiction to entertain an appeal from a decision of the Patent Office requiring such division.

The Court of Appeals of the District of Columbia is in accord with the Court of Customs and Patent Appeals that a decision requiring division is final, *Pitman v. Coe*, 68 F. 2d 412. So is this Court, *Steinmetz v. Allen*, 192 U. S. 543, 556:

"True, a distinction can be made between his ruling and one on the merits, if we regard the merits to mean invention, novelty or the like. But in what situation would an applicant for a patent be? If he yield to the rule he gives up his right of joinder. If he does not yield he will not be heard at all, and may subsequently be regarded as having abandoned his application. See 4894, Rev. Stat. A ruling having such effect must be considered as *final and appealable*" (italics supplied).

Not one of the three decisions cited by the respondent, therefore, supports the proposition that the Court of Customs and Patent Appeals will take jurisdiction of an appeal from the Patent Office prior to a final decision upon the whole merits.

That the Patent Office itself has heretofore understood that the Court of Customs and Patent Appeals will not entertain appeals from piecemeal decisions of the Patent Office is evident from *ex parte King*, 336 O. G. 3 *supra*. On page 8, the respondent says that, in this decision, Acting

Commissioner of Patents Kinnan was only construing Rule 139 of the Rules of Practice of the Patent Office (quoted in the Appendix), and not either Section 4911 or Section 4915 of the Revised Statutes.

Quite true. But that construction of Rule 139 was admittedly based upon, so as to be in harmony with, the previous construction of the Court of Appeals of the District of Columbia of Section 4911 of the Revised Statutes (Pet. 33, the first complete paragraph). The Courts of Appeals of the District of Columbia and the Second Circuit and the Court of Customs and Patent Appeals are agreed as to this construction of Section 4911 of the Revised Statutes (Pet., bottom of page 27).

Commissioner Kinnan ordered that the application be remanded to the Primary Examiner in order that final action upon all the claims (*the whole merits*) might be obtained prior to compelling the applicant to appeal to the Court. If he had not done so, as Commissioner Kinnan himself explained (Pet. 33), the case would have come into

“the court without an issue having been reached as to part of the appealed claims,”

and the Court would then have refused to take jurisdiction upon the ground that the decision appealed from was not *final upon the whole merits*.

It should now be clear that none of the three decisions cited by the respondent supports his contention that, after the Patent Office piecemeal decision of 1941, the petitioner could have appealed to the Court of Customs and Patent Appeals, under the provisions of Section 4911 of the Revised Statutes.

What is more important, insofar as the present petition is concerned, none of them supports the proposition that the petitioner could at that time have filed suit in the District Court under the provisions of Section 4915 of the Revised Statutes.

D. The Law As To Piecemeal Appeals In The Patent Office.

As explained on page 5, *supra*, the respondent suggests that, in the view of three of the numerous members of the Board of Appeals of the Patent Office, the doctrine *ex parte* King, *supra*, enunciated in 1927 by the head of the Patent Office, was no longer in force in 1941.

These three members of the Board of Appeals could not, however, undertake to speak for the remaining numerous members of that Board, and they could not undertake to overrule the law as to piecemeal appeals (p. 3, *supra*) as laid down by the dictum of this Court, the decisions of the Court of Appeals of the District of Columbia and the Court of Customs and Patent Appeals, or even the 1927 decision of their superior officer, the Commissioner of Patents.

The respondent has not cited any decision, prior to the decision in the case at bar, overruling *ex parte* King, *supra*, whether by the Commissioner of Patents, his subordinate Board of Appeals, or any other tribunal, whether in the Patent Office or any Court.

E. Hoover Co. v. Coe, 325 U. S. 79, Has Not Changed the Practice Relating to Piecemeal Appeals.

Irrespective of what the Court of Appeals of the District of Columbia, the Court of Customs and Patent Appeals and the Patent Office have heretofore decided as to piecemeal appeals, however, "The sole question presented

by the petition herein'', as posed by the respondent himself (page 5), is as to whether this Court, in *Hoover Co. v. Coe, supra*, has revolutionized the practice with respect to piecemeal appeals. It is now in order, therefore, to look into that matter.

By way of background, as stated on page 6 of the respondent's brief, the Patent Office had refused to allow to a reissue applicant certain claims copied from another's patent upon the ground that they did not read on the reissue applicant's disclosure. Without allowing those claims, of course, the Patent Office could not comply with the reissue applicant's request for an interference with that patent.

The reissue applicant, therefore, was compelled to jump two hurdles before he could obtain a reissue patent containing those copied claims: first, to obtain a ruling that the copied claims did read on his disclosure; and secondly, to prove, by testimony in an interference, that he was the prior inventor of the subject matter of those copied claims.

It was impossible, however, for the reissue applicant even to reach the second hurdle until after overcoming the first. The interference with the patent that he asked for could not even be set up until he had first obtained a ruling to the effect that the copied claims did read upon his disclosure.

The reissue applicant proposed to obtain that ruling through the medium of a suit filed in the District Court under the provisions of Section 4915 of the Revised Statutes.

The District Court entertained jurisdiction over the suit. The Court of Appeals of the District of Columbia, 144 F. 2d 514, *supra*, however, dismissed the appeal.

The reason advanced for the dismissal was that, even in the event of a holding favorable to the reissue applicant, the Commissioner of Patents could not have granted the reissue patent; this because there was something further for the Patent Office to do before grant, namely, to declare an interference between the reissue applicant and the patent from which the claims had been copied. The Court of Appeals of the District of Columbia considered that a decree authorizing the Commissioner of Patents to grant a patent, under circumstances where such authorization constituted only a step in further proceedings that might or might not lead ultimately to the grant of the patent, would have afforded only (Respondent's brief, page 6)

“piecemeal relief pending completion of the administrative process.”

Under such reasoning, as this Court pointed out on pages 88 and 89 of its decision in *Hoover Co. v. Coe*, *supra*, Section 4915 of the Revised Statutes would have become practically a dead letter. As appears from the very close of its decision, at page 517, indeed, that is precisely what the Court of Appeals tried to bring about.

As appears from Judge Learned Hand's discussion in *Sinko Tool & Manufacturing Co. v. Automatic Devices Corporation*, 136 F. 2d. 186, 190, this was not the first time that the Courts of the District of Columbia had been attempting to abdicate in favor of the Court of Customs and Patent Appeals.

On page 83 of its decision in *Hoover Co. v. Coe*, *supra*, this Court appreciates that an applicant in an *ex parte* case (as distinguished from an *inter partes* interference) is unable to obtain in the Court of Customs and Patent Appeals,

under the provisions of Section 4911 of the Revised Statutes, the kind of review that Congress intended that he should have in the District Court, under the provisions of Section 4915. Under the provisions of Section 4911, in the Court of Customs and Patent Appeals,

“the hearing is summary and solely on the record made in the Patent Office”.

But the petitioner did not want a summary hearing on the record made in the Patent Office. He wanted to present testimony that the Patent Office had refused to receive. Under the provisions of Section 4915 of the Revised Statutes, Congress had enabled the petitioner to present such testimony in the District Court, through the medium of “a formal trial”

“On proof which may include evidence not presented in the Patent Office.”

The real question presented in the Hoover Co. case, *supra*, therefore, was whether an applicant for patent, in an *ex parte* proceeding, shall or shall not be afforded a forum where he may present evidence that the Patent Office refuses to entertain. Congress had intended to answer this question in the affirmative through the enactment of Section 4915 of the Revised Statutes. The Courts of the District of Columbia, on the other hand, had apparently been trying to nullify this Congressional intent.

If the Courts of the District of Columbia are so heavily burdened that they cannot do justice in suits under the provisions of Section 4915 of the Revised Statutes, perhaps legislation should be enacted that will afford an applicant for patent elsewhere than in the District Court the hearing that he cannot obtain in the Patent Office. At the present time, however, the only place where he can obtain this hearing is in the District Court, under the provisions of Section 4915 of the Revised Statutes.

It would appear not to promote the progress of science and useful arts, as provided for in Article 1, Section 8, of the United States Constitution, for the legislative branch of the government to encourage inventors by promising them an opportunity to present their side of the case by testimony, and for the judicial branch of the government then to discourage them by refusing to hear their testimony.

The decision of this Court, in *Hoover Co. v. Coe, supra*, therefore, merely so interpreted Section 4915 of the Revised Statutes as to restore to applicants for patent the opportunity that they had previously always had, and that Congress had always intended that they should have, to present in the District Court testimony that the Patent Office would not hear. In order to effect this result, this Court had to rule that the decision of the Patent Office holding that the copied claims did not read on the reissue applicant's disclosure was a final decision. It might have paraphrased its own previous holding (see p. 15, *supra*) in *Steinmetz v. Allen, supra*:

"True, a distinction can be made * * * if we regard the merits to mean invention, novelty or the like. But in what situation would an applicant for a patent be? If he yield to the ruling of the Court of Appeals of the District of Columbia, he gives up his right to present testimony in the District Court, and he will not be able to obtain a review of the Patent Office decision based upon such testimony. If he does not yield he will not be put into interference with the patent the claims of which he copied for interference purposes and may subsequently be regarded as having abandoned his application."

Unfortunately, however, the decision in *Hoover Co. v. Coe, supra*, has now been construed to have a meaning that, it is believed, this Court never intended that it should have, namely, that the applicant is now compelled to avail him-

self of the opportunity to present his testimony in the District Court following promptly upon every piecemeal decision of the Patent Office adjudicating (page 3, *supra*) "any claim", "any individual claim", or "any one" of the claims of his application for patent.

The respondent says (page 7), first, that there is nothing in the record of the Hoover Co. case

"to indicate that in that case all claims had been disposed of prior to the bringing of the suit;"

and secondly, that

"there is nothing in this Court's opinion to indicate * * * that the final disposition of all claims was considered by this Court as a condition precedent to the bringing of the suit."

With regard to the first of these two arguments, the footnote on page 7 invites attention to the fact that pages 113 to 115 of the record in the Hoover Co. case show that claims 1 to 23 and 34 to 41 were alone acted upon by the primary examiner of the Patent Office on March 28, 1941, and that no action was taken on that date with respect to the remaining claims 24 to 33.

The respondent's brief is signed, among others, by the solicitor and the attorney for the respondent. As the respondent, his solicitor and his attorney naturally all have access to the complete Patent Office record of the Hoover Co. case, they could have informed this Court as to the exact disposition that had previously been made by the primary examiner of these remaining claims 24 to 33; whether, as the footnote puts it, they "had been cancelled or previously rejected, or were still pending".

The petitioner is unable to furnish that information for, in common with other members of the public, he does not have access to that record.

It must be presumed, however, that those claims 24 to 33 had already in some manner been disposed of prior to the date of the said letter of March 28, 1941, so that it was not necessary for the primary examiner to refer to them any longer. It cannot be presumed that the primary examiner had refused arbitrarily to perform his duty of acting upon all the claims of the reissue application, and that the reissue applicant would have acquiesced in such arbitrary refusal.

It is believed, however, that the District Court, the Court of Appeals of the District of Columbia and this Court were all under the impression, whether or not it was an actual fact, that all the claims of the reissue application had been disposed of prior to the bringing of the suit in the District Court. It is believed that all three of these Courts would have refused to entertain jurisdiction of a suit in a case involving only a piecemeal decision in the Patent Office. "On its own motion", 144 F. 2d 514, *supra*, the Court of Appeals would certainly have "raised the question" if it had had the least suspicion that there was any additional reason in support of its holding that (Respondent's brief, page 6).

"a court of equity ought not to afford piecemeal relief pending completion of the administrative process."

Even if it be assumed, therefore, that, in actual fact, the Patent Office did not finally pass upon those remaining claims 24 to 33 prior to the entry of the suit in the District Court, it was merely an oversight that the question of jurisdiction was not raised on the motion of the Court itself. As in *The Baldwin Company v. R. S. Howard Company*, 256 U. S. 35, 40, therefore,

"No question of the jurisdiction of the court was considered in that case, and an inadvertent allowance of the writ of certiorari does not establish the jurisdiction of the court."

The respondent's second argument, that this Court did not

"indicate * * * that the final disposition of all claims was considered by this Court as a condition precedent to the bringing of the suit"

appears to be fully answered on page 90 of this Court's decision:

"The ruling of the Board of Appeals in the instant case was neither a procedural ruling nor an interlocutory one."

It could have been nothing else, therefore, than a final ruling. This second argument appears to be answered further by this Court's comparing the ruling of the Board of Appeals to "a dismissal of a suit in a court". This Court could not have intended to make such a comparison in a case where it could have known that the Board of Appeals had passed upon part only of the claims in controversy. A more consistent comparison would in that event have been with a dismissal of *part only* of a suit in a court (Pet. 30).

It would therefore appear that when this Court, in *Hoover Co. v. Coe*, *supra*, so interpreted Section 4915 of the Revised Statutes as to give full effect to the Congressional intent that an applicant for patent, since he is not allowed to present testimony in the Patent Office, shall be afforded an opportunity to do so in the District Court, it did not mean by that interpretation to revolutionize the practice relating to piecemeal appeals.

2. *The Words "His Claim Or For Any Part Thereof" In Section 4915 Of The Revised Statutes Relate To The Relief That The District Court May Give, And Not To Its Jurisdiction.*

The history on page 9 of the respondent's brief leading up to the establishment of the present-day practice, according

to which a patentee sets forth "his claim" in the form of numbered paragraphs, instead of only a single claiming paragraph, is in full accord with the petitioner's statement (Pet. 26) that "his claim" means *all the claims*, and not merely *any claim*.

On page 469 of Lutz's article referred to by the respondent, in Volume 20 of the Journal of the Patent Office Society, for example, mention is made of the claim of Goodyear's reissue patent No. 156 of 1849 as affording an illustration of the prior practice. This claim is quoted in *Goodyear v. Central R. Co. of N. J.*, 10 Fed. Cas. 5,563, at the bottom of page 665:

"What I *claim* as my invention, and desire to secure by letters patent, is, the curing of caoutchouc or India rubber, by subjecting it to the action of a high degree of artificial heat, substantially as herein described, and for the purposes specified. And I *also claim* the preparing and curing the compound of India rubber, sulphur, and a carbonate or other salt or oxide of lead, by subjecting the same to the action of artificial heat, substantially as herein described" (italics supplied).

This "claim" of Goodyear's reissue patent, however, would still have been "his claim" if it had been in the form of two separate numbered paragraphs, instead of in the form of this single unnumbered paragraph.

Lutz gives also further illustrations, including *Appleton v. Chambers*, 1 Fed. Cas. 497a. At page 1073, the Court said that the patentee, in a single unnumbered paragraph, stated:

"his claim * * * very minutely * * * under eleven heads or divisions."

The "eleven heads or divisions" would still have constituted "his claim" if the patentee had stated them, as under present-day practice, in the form of eleven separately numbered paragraphs.

On this page 1073, the Court also referred to a decision of the Commissioner of Patents allowing a patent

“upon the third and fourth sections of his claim, when he shall have cancelled the two first sections thereof.” Under present-day practice, these four sections of “his claim” would be presented in the form of separately numbered claims 1 to 4, and the Commissioner of Patents would allow claims 3 and 4 and reject claims 1 and 2.

At the top of page 10, the respondent appears not to dispute the fact that, prior to the time when lawyers and judges began to talk in terms of separately numbered paragraphs or claims, this very Court, as in *Seymour v. Osborne*, 11 Wall 516, 546, and *Merrill v. Yeomans*, 94 U. S. 568 (Pet. 26), had construed the expression “his claim” to refer to *all* the claims of a patent. The respondent objects, however, that these two decisions involved suits for patent infringement, and not suits under the provisions of Section 4915 of the Revised Statutes.

The pertinency of this objection is not obvious. In those two cases, this Court was not construing terminology occurring in a statute relating to patent infringement, and the expression “his claim” was not used in connection with the matter of patent infringement. This Court was construing the meaning of a term, “his claim,” that was at that time in common use. The respondent’s objection appears not to throw any light upon the meaning of the term “his claim”; whether, at that time, it meant *any* claim of the patent, or *all* the claims.

In *Seymour v. Osborne*, *supra*, Seymour had obtained an original patent that, as appears from the bottom of page 558 of this Court’s decision, had contained at least two claims. As appears from a footnote on page 518, this original patent was reissued in the form of at least two reissue

patents, Nos. 72 and 1683, each of which, as appears from the top of page 524, contained at least one *claim*. On page 546, this Court referred to

“the specification and *claim*, both in the original and reissued patents” (italics supplied),
irrespective of whether the patent contained only a single *claim* or several claims.

In *Merrill v. Yeomans, supra*, at page 570, similarly, this Court spoke of the “distinct and formal *claim*” that “comes at the close of the schedule or specification.” This Court spoke advisedly of this “claim,” in the singular, notwithstanding that, in the very next breath, it recognized the fact that this “*claim*” was constituted of “two separate claims.”

It is in this sense that the expression “his claim” was, from the very first, used in Section 4915 of the Revised Statutes.

On page 9, however, the respondent says that, since Section 4915 of the Revised Statutes authorizes the District Court to determine whether the

“* * * applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim *or for any part thereof*, as the facts in the case may appear” (italics the respondent’s),

therefore,

“This indicates that the controversy presented may be the validity of only a part of the subject matter of the entire application.”

It is believed, however, that the respondent is confusing the question of jurisdiction with that relating to what relief the Court may give, once it has acquired jurisdiction.

In former times, when “his claim” was presented in the form of a single unnumbered paragraph, a District Court, like the Commissioner in *Appleton v. Chambers*, page 26, *supra*, might have “adjudged”

“that such applicant is entitled, according to law, to receive a patent for his invention, as specified in” “the third and fourth sections of his claim.” These third and fourth sections would have constituted the “any part thereof,” that is, of “his claim,” as specified in the statute. Under present-day practice, with these four sections of “his claim” in the form of separately numbered paragraphs, the Court would similarly “adjudge” with respect to the “part” of “his claim” involving claims 3 and 4.

A similar provision is found in Section 4918 of the Revised Statutes (U. S. C., title 35, sec. 66):

“Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either or both the patents void *in whole or in part* upon any ground, or inoperative, or invalid *in any particular part* of the United States, *according to the interest of the parties* in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment” (italics supplied).

The words of Section 4915 of the Revised Statutes, “*or for any part thereof*,” italicized by the respondent, therefore, like the corresponding italicized words of Section 4918 of the Revised Statutes, have nothing whatever to do with jurisdiction. They have rather to do with the nature of the relief that may be “adjudged” by the Court, “as the facts in the case may appear,” once jurisdiction has already been acquired after a *final* decision by the Patent Office upon the *whole merits*.

3. *The Different Language of Sections 4909 and 4915 of the Revised Statutes Serves But to Emphasize That a Suit Under Section 4915 May Not Be Filed Until After a Final Decision Upon the Whole Merits.*

On page 8, the respondent contrasts the wording of Section 4915 of the Revised Statutes, conferring jurisdiction upon the District Court, with Section 4909 of the Revised Statutes, conferring jurisdiction upon the Board of Appeals of the Patent Office. The Board of Appeals, under the provisions of Section 4909 of the Revised Statutes, has jurisdiction to consider

*"any of the claims * * * which have been twice rejected"* (Respondent's italics).

In this Section 4909, therefore, Congress has recognized the fact that, within the Patent Office itself, there are occasions when it is advantageous to permit the Board of Appeals to decide the merits, one claim at a time.

Under the provision of Section 4915 of the Revised Statutes, on the other hand, the District Court does not have jurisdiction

"Whenever any of the claims of a patent on application is refused by the Board of Appeals."

It does not, therefore, have jurisdiction to decide the merits, one claim at a time. On the contrary, it has jurisdiction only

"Whenever a patent on application is refused by the Board of Appeals";

and its jurisdiction may therefore be invoked only when the Board of Appeals has rendered a *final* decision upon the *whole merits*.

A "final" decision upon the "whole merits," as stated by this Court as long ago as in *Beebe v. Russell*, 19 How. 283, 285 (Pet. 20), is a decision such

“that it will not be necessary to bring the cause again before the court for its final decision.”

Under the construction contended for by the respondent, on the other hand, the cause would be brought before the court again and again, after each piecemeal “rejection of any claim” (Respondent’s brief, page 8).

In the present case, for example, it would have been necessary to file two complaints under the provisions of Section 4915 of the Revised Statutes: one, in 1941, relating to the static-inverter claims 74 and 76 to 81; and the other, in 1945, relating to claim 222.

CONCLUSION

There appear to be two questions for consideration on this petition: the “sole” question and the “academic” question.

Insofar as the “academic” question is concerned, the uncontradicted, undisputed and unimpeached testimony demonstrates that the petitioner is the prior inventor of the subject matter set forth in the static-inverter claims 74 and 76 to 81. As in *Clements v. Kirby*, 274 F. 575, 577, a technical rule (relating to *res judicata*) has been so applied

“as to divert the patent from the true inventor to another.”

The answer to the “sole” question shows, however, that there is no basis even for applying this technical rule.

According to the dictum of this very Court (p. 4, *supra*), the District Court may not entertain a suit under the provisions of Section 4915 of the Revised Statutes except after a *final* decision upon the *whole* merits.

The Court of Appeals of the District of Columbia had also previously consistently ruled (p. 4, *supra*) that a

District Court may not entertain jurisdiction of a suit under the provisions of Section 4915 of the Revised Statutes except after a *final* rejection of an application.

The respondent appears to be mistaken (pp. 15 to 17, *supra*) in his understanding that the Court of Customs and Patent Appeals will entertain jurisdiction of a piecemeal appeal under Section 4911 of the Revised Statutes.

The respondent has offered no evidence that the Commissioner of Patents has ever overruled his own decision in *ex parte* King, *supra*.

These decisions have all been in accordance with "the general rule," going back to very ancient times, according to which (Respondent's brief, page 5),

"the piecemeal disposition on appeal of a single controversy is not permissible (Pet. 15-24)."

It is believed that this Court, in *Hoover Co. v. Coe*, *supra*, has not intended to revolutionize this ancient practice. It is believed that this Court has not intended to discriminate against applicants for patent by excluding them from the benefits of this "general rule," so as to compel them, from now on, unlike other citizens, to be subjected to the heavy burden of appeal after appeal, every time that the Patent Office may render a separate decision relating to "any individual claim" (Respondent's brief, page 6, line 4). Attention is invited to page 5 of the Petition.

As this Court said, in *United States v. Dubilier Condenser Corp.*, 289 U. S. 178, 186,

"An inventor deprives the public of nothing which it enjoyed before his discovery, but *gives something of value* to the community * * * In consideration of * * * the consequent *benefit to the community*, the patent is granted" (italics supplied).

The patent is thus granted, *Seymour v. Osborne*, *supra*, at page 533,

“as matter of compensation to the inventors for their labor, toil, and expense in making the inventions, and reducing the same to practice for the *public benefit*” (italics supplied).

It is believed that this Court, in *Hoover Co. v. Coe, supra*, has not intended to increase the burdens of these public benefactors. It is believed, on the contrary, that this Court has tried to aid them. It has tried to carry into effect the Congressional intent, as expressed in Section 4915 of the Revised Statutes. It has tried to restore to inventors the opportunity that they had previously had, but which had been taken away by the lower-court decision in the *Hoover Co.* case, of presenting in the District Court testimony that the Patent Office will not accept.

It is therefore respectfully submitted that the petition for the writ of certiorari should be granted.

Respectfully submitted,

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APPENDIX

Rule 139 of the Rules of Practice in the United States
Patent Office

"139. The board of appeals in its decision shall affirm or reverse the decision of the primary examiner only on the points on which appeal shall have been taken. (See rule 133.) *Should it discover any apparent grounds not involved in the appeal for granting or refusing letters patent in the form claimed, or in any other form, it shall include in its decision a statement to that effect with its reasons for so holding.*

This statement of the board of appeals, if adverse to applicant's right to a patent, will reopen the case for amendment or showing of facts, or both, before the primary examiner responsive thereto. The statement shall be binding upon the primary examiner unless an amendment or showing of facts not previously of record be made which, in the opinion of the primary examiner, avoids the additional grounds for refusal of the patent stated in the decision.

The applicant may waive the right to further prosecution before the primary examiner and have the case reconsidered by the board of appeals upon the same record. Where request for such reconsideration is made the board of appeals shall render a new decision which shall include *all grounds upon which a patent is refused. The applicant may waive reconsideration by the board of appeals and treat the decision, including the added grounds for refusal of a patent given by the board of appeals, as a final decision in the case.*

Should the decision of the board of appeals include a statement that the patent may be granted in amended form, applicant shall have the right to amend in conformity with such statement, which shall be binding on the primary examiner in the absence of new references or grounds of rejection" (italics supplied).